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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/005, 105 01/09/98 BEATTY

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EXAMINER

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ART UNIT

PAPER NUMBER

3736

**DATE MAILED:**

10/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/005,105

Applicant(s)

Beatty et al.

Examiner

Eric Winakur

Group Art Unit

3736

 Responsive to communication(s) filed on Jul 19, 1999 This action is **FINAL**. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

 Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 1-8 and 12-38 is/are withdrawn from consideration.

 Claim(s) \_\_\_\_\_ is/are allowed. Claim(s) 9-11 is/are rejected. Claim(s) \_\_\_\_\_ is/are objected to. Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

 See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner. The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

 Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

 Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1 - 8 and 12 - 28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 2. Applicant's request for reconsideration of the election requirement with regard to claims 26 - 28 is noted. The request is hereby denied in view of the election without traverse during the telephone conversation of February 8, 1999. (see MPEP 819 and 821.02)

2. Newly submitted claims 29 - 38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to a subcombination of the elected claims. The combination of claims 9 - 11 does not require a signal generator controlled by a computer interface which is adapted to monitor passive electrodes and drive active electrodes, as set forth in claim 29. The subcombination has separate utility as an interface for an externally applied electrode system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29 - 38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. With regard to the objection to the drawings in the previous Office Action, Examiner notes that Applicant will submit formal drawings which include the requested changes after indication of allowable subject matter.

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5. Claims 9 - 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 9, the punctuation of line 16 appears to be incorrect.

6. The rejection of claims 9 - 11 under 35 U.S.C. 103(a) as being unpatentable over Budd et al. in view of Ben-Haim is hereby maintained. Applicant appears to argue that the effective filing date of the claimed subject matter should be that of the grandparent case, September 23, 1992 [see MPEP 706.02]. Although Applicant alleges coverage for some of the claimed subject matter, there is no evidence 1) that each claimed element of the instant invention is supported under 35 U.S.C. 112 in the grandparent case, and 2) that there was continuity of disclosure of the claimed subject matter under 35 U.S.C. 112 in the parent case (08/387,832) as well. In particular, the grandparent case teaches a multi-electrode array catheter with an integral reference electrode. It is unclear what provides a teaching of both a set of passive measurement electrodes and a set of active interrogation electrodes, as set forth in the claims. In addition, it is unclear what elements of the grandparent case provide a teaching of the converter means for converting numerical representations to a set of wall distance measurements and converter means for generating a graphic representation from the set of wall distance measurements. Further, it is unclear what teaching of the grandparent case teaches the subject matter of claims 10 and 11. It is noted that Applicant has not argued any other aspects of the combination.

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Winakur whose telephone number is (703) 308 - 3940. The examiner can normally be reached on Monday - Thursday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cary O'Connor, can be reached on (703) 308- 2701. The fax phone number for this group is (703) 308 - 0758.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 - 0858.

Eric F. Winakur  
Art Unit 3736  
October 12, 1999

S. W.